

REMARKS

The applicants note with appreciation the acknowledgement of the claim for priority under section 119 and the notice that all of the certified copies of the priority documents have been received.

The applicants acknowledge and appreciate receiving an initialed copy of the form PTO-1449 that was filed on August 14, 2001.

Claims 1 – 6 are pending. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claim 1 was objected to for various informalities. Wording similar to that suggested in the office action has been adopted. Withdrawal of the claim objection is respectfully requested.

Claims 4 – 6 were rejected under 35 USC 102(b) as being anticipated by U.S. Patent 4,652,108, Iida et al. (“Iida”). The rejection is respectfully traversed for reasons including the following, which are provided by way of example.

Independent claims 4 and 5 are directed to data transmission by a radio signal. As further claimed, the number of times of the switching operations of the voltage boosting means (14) can be increased as time passes (e.g., Fig. 5).

Claim 4 provides for a battery. There is also provided a voltage boosting control signal generating means for sequentially generating a voltage boosting control signal pulses through application of an output voltage of the battery as a power source voltage. A voltage boosting means executes a switching operation through input of the voltage boosting control signal and also executes the voltage boosting operation to boost the output voltage of the battery up to a predetermined voltage based on the switching operation. Transmitting means operated with the

boosted voltage transmits data as a radio signal. The voltage boosting control signal generating means sequentially generates the voltage boosting control signal to further increase the number of times of the switching operation of the voltage boosting means as time passes thereby to recover a drop of the output voltage of battery caused by the switching operation.

Claim 5 provides for a method of operating a signal transmitter having a battery and a signal transmitter circuit operable with an output voltage of the battery. A voltage is generated boosting control signal having an ON-period and an OFF-period at a first fixed frequency, the ON-period being increased as time passes. A switching pulse is generated at a second fixed frequency higher than the first fixed frequency during the ON-period of the voltage boosting control signal so that the switching pulse is generated at least once in each ON-period of the switching pulse. The output voltage of the battery is boosted in response to the switching pulse so that the transmitter circuit is operated with the boosted output voltage.

On the other hand, without conceding that Iida discloses any feature of the present invention, Iida is directed to providing a driving device for an object illuminating lamp capable of providing a stable light intensity even in the presence of a significant variation in the power source voltage (e.g., Col. 1, lines 44 – 48). Iida is directed to a flash lamp control, which is different from transmitting data as a radio signal.

The office action asserts that Iida anticipates the invention as claimed. To the contrary, Iida fails to set forth each and every element found in the claims. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226,

1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Iida fails to teach or suggest, for example, “transmitting means operated with the boosted voltage for transmitting data as a radio signal” or operating “a signal transmitter circuit” (e.g., claim 4, claim 5) . The office action states that the flash tube (8) of Iida constitutes the “transmitting means … for transmitting data as a radio signal” and the “signal transmitter circuit.”

The contention that transmitting data as a radio signal is “inherent as light” is respectfully traversed. To the contrary, it is not necessary that data transmitted as a radio signal is “inherent as light” transmitted from a flash tube, or vice versa. That something may occur or be present in the prior art, which applicants vigorously deny, is insufficient to establish inherency. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thin described in the reference, and that it would be so recognized by persons of ordinary skill.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). In order to support a contention of inherency, the allegedly inherent characteristic must necessarily flow from the teachings of the reference. *In re Levy*, 17 USPQ2d 1461, 1464 (Bd Pat. App. & Inter. 1990). Accordingly, the Examiner is respectfully requested to provide a citation to a reference or an Examiner’s affidavit, or to withdraw the rejection. 37 CFR 1.104(d)(2); MPEP 2144.03. With respect to claim 5, the office action does not explain why the flash tube (8) of Iida constitutes a signal transmitter circuit. It is respectfully submitted that Iida’s flash tube fails to teach or suggest a signal transmitter circuit.

Also, Iida fails to teach or suggest that “the voltage boosting control signal generating means sequentially generates the voltage boosting control signal to further increase the number of times of the switching operation of the voltage boosting means as time passes ...” (Claim 4.) The office action cites Iida, Figs. 3 and 4 and columns 4 and 5 as being particularly relevant to this recitation. However, these portions of Iida are related to a driving circuit for a monitor lamp 11. Not only is the flash tube different from the transmitting means for transmitting data as a radio signal, the driving circuit 10 and its operation is not related to the flash tube 8.

Iida further completely fails to teach or suggest that the switching operations in the voltage boosting control signal be increased as time passes, or the “ON-period being increased as time passes.” (See claims 4, 5.) Col. 4 line 1 – Col. 5 line 52, cited as particularly relevant to claim 4, simply fail to teach or suggest this element. No portion of Iida is cited with respect to this recitation in claim 5. The applicants have carefully reviewed the cited portions of the reference and fail to note any such teaching. If the examiner maintains this refusal, she is respectfully requested to point out with particularity the location of this particular teaching in Iida.

Iida fails to teach or suggest, for example, these elements recited in independent claims 4 and 5. It is respectfully submitted therefore that claims 4 and 5 are patentable over Iida.

For at least these reasons, the combination of features recited in independent claims 4 and 5, when interpreted as a whole, is submitted to patentably distinguish over the prior art. In addition, Iida clearly fails to show other claimed features as well.

With respect to the rejected dependent claims, applicant respectfully submits that claim 6 is allowable not only by virtue of its dependency from independent claim 5, but also because of additional features it recites in combination.

New claims 7 – 15 have been added to further define the invention, and are believed to be patentable for reasons including those set out above. Support for claims 7 – 9 is located in, for example, page 9, lines 1 – 4; and page 24, line 25 – page 25, line 1. Support for claims 10 – 15 is located in, for example, page 11, lines 4 – 17.

The applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. The applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, the applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

The applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples the applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, the applicants have provided examples of why the claims described above are distinguishable over the cited prior art.

In view of the foregoing, the applicants respectfully submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,



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